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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,699	01/24/2001	Klaus Dietrich	P00,1896	3711

7590 01/20/2004

SCHIFF HARDIN & WAITE

Patent Department

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EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,699

Applicant(s)

DIETRICH ET AL.

Examiner

John M Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Status

Claims 1-9 remain pending.

Response to Arguments

The Applicants arguments filed on October 31, 2003 have been fully considered.

The pending claims are rejected in view of the newly discovered reference Gelfer et al. (US Patent 6,587,843). The Official Notice taken in claims 1 and 9 is hereby withdrawn.

The Applicant states that features of "the security module multiply interrogating the control unit" and "security module automatically deactivating itself, and thereby precluding printing of said postage value stamp, if said control unit hands over an incorrect security code or no security code upon each interrogation" is incompatible and inconsistent with the security procedures set forth by Leon.

The Examiner states that in regards to the deactivation of the security module the Gelfer et al. reference discloses a security flag that is interrogated in franking mode, failure to obtain the correct flag, or lack of flag renders the franking machine inoperable.

Examiner states that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) "To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.", the Examiner states the cited references deal with the generalized problem of secure postage metering and therefore would be obvious to a person of ordinary skill in the art to combine aspects from the Leon et al. reference with the Gelfer et al. reference to derive the presently claimed invention.

See following rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon et al. (US Patent 6,591,251) in view of Gelfer et al. (US Patent 6,587,843).

As per claim 1,

Leon et al. ('251) discloses a postage meter machine for franking postal items, comprising:

a printer adapted for printing a postage value stamp on a postal item; (column 4, lines 19-23)

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a control unit for controlling operation of at least said printer;(Figure 2)
a security module, for debiting postage fee data used for producing said postage value stamp, which must be activated to permit said control unit to control said printer, said security module being electronically connected to said control unit.(column 6, lines 36-43)

Leon et al. ('251) does not disclose "automatically, multiply interrogating said control unit to require handover of a security code from said control unit to said security module" Gelfer et al. (843) discloses "security module automatically deactivating itself, and thereby precluding printing of said postage value stamp, if said control unit hands over an incorrect security code or no security code upon each interrogation"(Column 13, lines 32-34). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Leon et al. method with the Gelfer et al. method in order to prevent manipulations that lead to non-debited franking of postal items.

Leon et al. ('251) does not disclose "security module automatically deactivating itself, and thereby precluding printing of said postage value stamp, if said control unit hands over an incorrect security code or no security code upon each interrogation" Gelfer et al. (843) discloses "security module automatically deactivating itself, and thereby precluding printing of said postage value stamp, if said control unit hands over an incorrect security code or no security code upon each interrogation"(Column 12, lines 1-18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Leon et al. method with the Gelfer et al. method in order to prevent manipulations that lead to non-debited franking of postal items.

As per claim 2,
Leon et al. ('251) discloses a postage meter machine as claimed in claim 1,
wherein said security module contains a module computing unit for conducting said multiple interrogations of said control unit, at regular time intervals. (column 5, lines 13-24)

As per claim 3,
Leon et al. ('251) discloses a postage meter machine as claimed in claim 1.
Official Notice is taken that "security module contains a module computing unit for conducting said multiple interrogations of said control unit, at irregular time intervals" is common and well known in prior art in reference to security systems. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a security module containing a module computing unit for conducting said multiple interrogations of said control unit, at irregular time intervals in order to create a more secure system.

As per claim 4,
Leon et al. ('251) discloses a postage meter machine as claimed in claim 1.
wherein said security module contains a timer which deactivates said security module after expiration of a time duration following a last handover of a correct security code from said control module, if a further handover of said correct security code does not occur within said time duration. (column 6, lines 51-62)

As per claim 5,

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Leon et al. ('251) discloses a postage meter machine as claimed in claim 4.

Official Notice is taken that "wherein said timer randomly varies said time duration" is common and well known in prior art in reference to security systems. It would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the timer randomly to create a more secure system.

As per claim 6

Leon et al. ('251) discloses a postage meter machine as claimed in claim 1, wherein said security module, after deactivation, automatically re-activates itself upon handover of a security code from said control unit to said security module. (column 7, lines 1-5)

As per claim 7

Leon et al. ('251) discloses a postage meter machine as claimed in claim 1, wherein said control unit contains hardware having an identifier code associated therewith, and wherein said control unit and said security module use said hardware identifier code as said security code. (column 6, lines 16-19)

As per claim 8

Leon et al. ('251) discloses a postage meter machine as claimed in claim 1, wherein said control unit encrypts said security code, prior to handing said security code over to said control unit, to form an encrypted security code, and wherein said control unit hands over said encrypted security code to said control unit. (column 6, lines 16-34)

As per claim 9

Leon et al. ('251) discloses in a postage meter machine having a control unit for controlling printing of a postage value imprint on a postal item, the improvement of a security module, which must be activated to allow controlling of printing by said control unit, comprising:

at least one security module component (column 6, lines 36-43)

Leon et al. ('251) does not disclose "automatically, multiply interrogating said control unit to require handover of a security code from said control unit to said security module" Gelfer et al. (843) discloses "security module automatically deactivating itself, and thereby precluding printing of said postage value stamp, if said control unit hands over an incorrect security code or no security code upon each interrogation"(Column 13, lines 32-34). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Leon et al. method with the Gelfer et al. method in order to prevent manipulations that lead to non-debited franking of postal items.

Leon et al. ('251) does not disclose "deactivating said security module if said control unit hands over an incorrect security code or no security code" Gelfer et al. (843) discloses "deactivating said security module if said control unit hands over an incorrect security code or no security code"(Column 12, lines 1-18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Leon et al. method with the Gelfer et al. method in order to prevent manipulations that lead to non-debited franking of postal items.

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Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

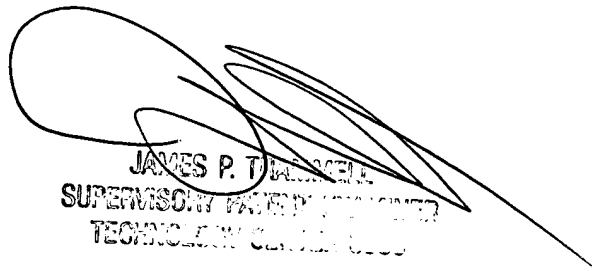
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW

December 12, 2004


JAMES P. TRAMMELL
SUPERVISOR, PATENT EXAMINER
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